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MAILED
JUN 21 2010
OFFICE OF PETITIONS

In re Application of :
Doms et al. : DECISION ON APPLICATION
Application No. 10/032,311 : FOR
Filed: December 21, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. 130694.05811 :

This is a decision on the REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed March 9, 2010, which is properly treated as a petition under 37 CFR 1.705(b). Applicants request correction of the patent term adjustment from four hundred seven (407) days to at least six hundred eighty-seven (687) days partly on the basis of the Office taking in excess of three years to issue the patent.

The request for reconsideration of the patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PALM and PAIR screens to reflect that the patent term adjustment determination at the time of the mailing of the notice of allowance is **four hundred thirty-six (436) days**. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to

On December 10, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 407 days.

Applicants dispute the 29 days of reduction, pursuant to 37 CFR 1.704(c)(8), for the filing of the Supplemental Response on July 20, 2006. Applicants assert that during a telephonic interview with the Examiner on July 6, 2006, the Examiner expressly requested that applicants submit the Supplemental Reply of July 20, 2006.

Pursuant to 37 CFR 1.704(c)(8):

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

It is undisputed that after filing an initial reply on June 21, 2006, applicants filed a Supplemental Reply on July 20, 2006. Nevertheless, the record supports a conclusion that the Examiner expressly requested the filing of the Supplemental Reply. Accordingly, the period of reduction of 29 days is unwarranted and will be removed.

In view thereof, the patent term adjustment determination at the time of the mailing of the notice of allowance is **four hundred thirty-six days (436) days** (639 days of Office delay - 203 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fee is required.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Thursday
Date: 6/17/2010

PALM INTRANET

Time: 13:53:17

PTA Calculations for Application: 10/032311			
Application Filing Date:	12/21/2001	PTO Delay (PTO):	639
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	232
Post-Issue Petitions:	0	Total PTA (days):	436
PTO Delay Adjustment:	29		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
130	06/17/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	29		
124	12/10/2009	MAIL NOTICE OF ALLOWANCE			
123	12/07/2009	ISSUE REVISION COMPLETED			
122	12/07/2009	DOCUMENT VERIFICATION			
121	12/07/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
120	12/07/2009	NOTICE OF ALLOWABILITY			
117	10/14/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
116	09/22/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
115	10/20/2009	DATE FORWARDED TO EXAMINER			
114	10/14/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)			
113	10/20/2009	DISPOSAL FOR A RCE / CPA / R129			
112	10/14/2009	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
111	10/14/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
110	10/14/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
109	09/22/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
108	09/22/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
107	01/29/2009	RESPONSE TO REASONS FOR ALLOWANCE			
106	09/11/2009	FILING RECEIPT - CORRECTED			
105	05/26/2009	SUPPLEMENTAL PAPERS - OATH OR DECLARATION			

104	11/28/2007	SUPPLEMENTAL PAPERS - OATH OR DECLARATION			
103	08/25/2009	EXPORT TO INITIAL DATA CAPTURE			
102	08/21/2009	MAIL EXAMINER'S AMENDMENT			
101	08/21/2009	MAIL NOTICE OF ALLOWANCE			
100	08/19/2009	ISSUE REVISION COMPLETED			
99	08/19/2009	DOCUMENT VERIFICATION			
98	08/18/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
97	08/18/2009	EXAMINER'S AMENDMENT COMMUNICATION			
96	08/18/2009	NOTICE OF ALLOWABILITY			
92	05/26/2009	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
91	06/15/2009	DATE FORWARDED TO EXAMINER			
90	05/26/2009	RESPONSE AFTER NON-FINAL ACTION		3	89
89	02/23/2009	MAIL NON-FINAL REJECTION			
88	02/17/2009	NON-FINAL REJECTION			
87	10/30/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
86	01/29/2009	LETTER REQUESTING INTERVIEW WITH EXAMINER			
85	01/09/2009	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
84	01/07/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
81	10/30/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT		0	79
80	12/10/2008	DATE FORWARDED TO EXAMINER			
79	10/30/2008	RESPONSE AFTER NON-FINAL ACTION		92	76
78	10/30/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
77	10/30/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
76	04/30/2008	MAIL NON-FINAL REJECTION	39		71
75	04/28/2008	NON-FINAL REJECTION			
74	11/28/2007	RULE 47 / 48 CORRECTION OF INVENTORSHIP PAPERS FILED			
73	11/22/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
72	02/14/2008	DATE FORWARDED TO EXAMINER			

71	11/22/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
70	02/14/2008	DISPOSAL FOR A RCE / CPA / R129			
69	11/22/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
68	10/10/2007	FINISHED INITIAL DATA CAPTURE			
67	08/24/2007	EXPORT TO INITIAL DATA CAPTURE			
66	08/22/2007	MAIL NOTICE OF ALLOWANCE			
65	08/20/2007	ISSUE REVISION COMPLETED			
64	08/20/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
63	08/20/2007	CASE DOCKETED TO EXAMINER IN GAU			
62	08/20/2007	DOCUMENT VERIFICATION			
61	08/20/2007	NOTICE OF ALLOWABILITY			
60	08/08/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
59	08/08/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
58	08/08/2007	ELECTRONIC INFORMATION DISCLOSURE STATEMENT		0	56
57	08/13/2007	DATE FORWARDED TO EXAMINER			
56	08/08/2007	RESPONSE AFTER NON-FINAL ACTION		30	53
55	08/08/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
54	08/08/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
53	04/09/2007	MAIL NON-FINAL REJECTION			
52	04/02/2007	NON-FINAL REJECTION			
51	01/31/2007	DATE FORWARDED TO EXAMINER			
50	01/31/2007	MAIL APPEALS CONF. REOPEN PROSEC.			
49	01/26/2007	PRE-APPEALS CONFERENCE DECISION - REOPEN PROSECUTION			
48	12/18/2006	REQUEST FOR PRE-APPEAL CONFERENCE FILED			
47	12/18/2006	NOTICE OF APPEAL FILED			
46	10/17/2006	MAIL FINAL REJECTION (PTOL - 326)			
45	10/16/2006	FINAL REJECTION			
44	07/24/2006	DATE FORWARDED TO EXAMINER			
43	07/20/2006	SUPPLEMENTAL RESPONSE		29	41
42	06/21/2006	DATE FORWARDED TO EXAMINER			
41	06/21/2006	RESPONSE AFTER NON-FINAL ACTION			

40	03/22/2006	MAIL NON-FINAL REJECTION	83		32
39	03/20/2006	NON-FINAL REJECTION			
38	08/29/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
37	08/29/2005	REFERENCE CAPTURE ON IDS			
36.7	08/29/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	08/29/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	01/26/2006	DATE FORWARDED TO EXAMINER			
34	08/29/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
33	01/26/2006	DATE FORWARDED TO EXAMINER			
32	08/29/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
31	01/26/2006	DISPOSAL FOR A RCE / CPA / R129			
30	08/29/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
29	07/29/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
28	07/26/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
27	06/02/2005	MAIL FINAL REJECTION (PTOL - 326)			
26	05/31/2005	FINAL REJECTION			
25	03/28/2005	DATE FORWARDED TO EXAMINER			
24	03/17/2005	RESPONSE AFTER NON-FINAL ACTION		28	20
23	03/17/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
22	03/28/2005	CORRESPONDENCE ADDRESS CHANGE			
21	03/28/2005	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
20	11/17/2004	MAIL NON-FINAL REJECTION			
19	11/15/2004	NON-FINAL REJECTION			
18	09/01/2004	DATE FORWARDED TO EXAMINER			
17	08/23/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
16	08/23/2004	WORKFLOW INCOMING AMENDMENT IFW			
15	07/22/2004	MAIL RESTRICTION REQUIREMENT	517		-1
14	07/21/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
13	02/06/2004	CASE DOCKETED TO EXAMINER IN GAU			
12	12/09/2003	CASE DOCKETED TO EXAMINER IN GAU			
		IFW TSS PROCESSING BY TECH CENTER			

11	10/20/2003	COMPLETE			
10.7	09/20/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	09/20/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	07/30/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	07/24/2002	APPLICATION DISPATCHED FROM OIPE			
7	07/23/2002	APPLICATION IS NOW COMPLETE			
6	06/12/2002	ADDITIONAL APPLICATION FILING FEES		50	4
5	06/12/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
4	01/23/2002	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
2	01/15/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/21/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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